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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,138	04/30/2001	Hernan G. Otero	21710-68171	3105

28062 7590 10/08/2003

BUCKLEY, MASCHOFF, TALWALKAR, & ALLISON
5 ELM STREET
NEW CANAAN, CT 06840

EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/845,138

Applicant(s)
Maschoff

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 & 6 6) ☐ Other:

DETAILED ACTION

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3 1. It is acknowledged that Application 09/845,138 filed April 30, 2001 is a Continuation-
4 in-Part of Application 09/823,125 filed March 30, 2001, which also is a Continuation-in-Part
5 of Application 09/773,139 filed January 31, 2001 which claims benefit of 60/241,807 October,
6 14, 2000. Claims 1-32 are presented to be examined upon their merits.

Claim Rejections - 35 USC § 112

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11 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

12 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming
13 the subject matter which the applicant regards as his invention.

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15 3. Claims 1-5, 14-17 and 29--32 are rejected under 35 U.S.C. 112, second paragraph, as
16 being indefinite for failing to particularly point out and distinctly claim the subject matter
17 which applicant regards as the invention. There is no distinction between the trading strategy
18 of the first and second plug-in. It is therefore unclear as to the manner to which the first
19 and/or second plug-in are/is function in relation to each other. Therefore such claim(s) are
20 considered a mere duplication of parts which have no patentable significance being non-
21 patentable subject matter (see In re Harza, 124 USPQ 378).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over May (US 6,421,653 B1) in view of In re Harza, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960).

May discloses an apparatus, a method and an article for computerized trading over the Internet as claimed by the applicants' invention (see May figs. 2 & 3, Abstract; and col. 11, ll. 65 to col. 16, line 14). May fails to disclose the numerous plug-in features used particularly to implement and perform various trade activities as disclosed in claims 1 and 6-13, 14, 18-28 and 29-32.

However, May does disclose the use of the Java applets via a web browser (see May, col. 13, ll. 35+) to perform various trading functions (see May, col. 13, ll. 35+; and col. 16, ll. 20+). Java applets are a notoriously old and well known Java class that are loaded and run by a Java applications such as a Web-browser or applet viewer. Java applets can be downloaded and by any web browser, and are frequently used to add multi-media effects and interactivity to Web-pages.

1 The functional similarities of plug-ins and applets as they relate to adding functionality
2 to Web Browsers are notoriously old and well known in the art. Therefore it would have been
3 obvious for an artisan of ordinary skill in the art to recognize the similarities of plug-ins and
4 Java applets, being art recognized equivalents, and would have sought to use a plug-in software
5 as an alternative to Java applets to provide interactive functionality to electronic trading of
6 financial instruments within an Internet browser (see May, figs. 1-4 and figs. 24-33). Thus to
7 substitute the plug-ins for Java applets features disclosed in the May invention would provide
8 no unexpected results. Thus such a modification being obvious expedient to one of ordinary
9 skill in the art.

10 Additionally, May discloses various applets which perform different functions within
11 the invention to electronically trade financial instruments. Applicant discloses plug-ins (a first,
12 a second, a third and a forth plug-in) which perform the same function with no unexpected
13 result produced other than to implement various aspects of the trading strategy. Thus the
14 duplication of plug-ins within the invention are found obvious by In re Harza, because an
15 artisan of ordinary skill would recognize that the mere duplication of parts to provide the same
16 function of implementing a trading strategy, would produce no new or unexpected results and
17 thus have been obvious for one of ordinary skill in the art.

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Conclusion

6. A list of relevant prior art appears below not relied upon in this Office Action:

US Patents:

Gell et al (US 5,802,502) discloses a system for selective communications based transaction pricing signals

Rickard et al (US 6,016,483) discloses a method and apparatus for automated opening of options exchange

Belzberg (US 6,134,535) discloses a computerized stock exchange trading system automatically formatting orders from a spreadsheet to an order entry system

Mittal (US 6,233,609) discloses a method and apparatus for remote interaction with and configuration of a WAN based knowledge base

Bahreman (US 6,061,665) discloses a system, method and article of manufacture for dynamic negotiation of a network payment framework.

Foreign Patents:

Neyman (WO 01/98965) discloses a configurable anonymous trading system

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor ***Vincent Millin*** whose telephone number is (703) 308-1065.

8. Response to this action should be mailed to:

Serial Number: 09/845, 138

Applicant(s): Otero, et al. (705/37)

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Art Unit: 3624

Representative: Chovanes (33,481)

Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.



DSF

September 30, 2003



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600